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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,793

03/22/2004

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EXAMINER

BOVEJA, NAMRATA

ART UNIT

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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,793	Applicant(s) FERRELL, STANLEY MITCHELL	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/22/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 03/22/2004.
2. Claim 1 is presented for examination.

Objections

3. Claim 1 is objected to because of the following informalities. The claims recite "See Fig. 4," and figure numbers can change during prosecution if for example a drawing is cancelled. While MPEP §608.01(m) states that reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims, it does not state that Figure numbers can be included in the claim language. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101, because the claimed invention is directed to a non-statutory subject matter that is non-functional descriptive material. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter. Certain types of descriptive material, such as a contract, music, literature, art, photographs, and mere arrangements or compilations of facts or data such as "a listening supplement" and "highlights or cover

Art Unit: 3622

stories," are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, where such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" including data such as "a listening supplement" and "highlights or cover stories" is not a process, machine, manufacture, or composition of matter is therefore non-statutory. The claimed "data" elements are simply stored information. The "data" does not have any imparted functionality, it is therefore non-statutory material. The Applicant is not even claiming displaying or inputting of the data, which would all be functional steps, but is rather disclosing storage of mere data, which is by itself, is non-statutory, since it's data per se and non-functional descriptive material. All that is being said in most of the claim is that various data is being stored in a listening supplement.

Claim Rejections - 35 USC § 112

5. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is not sufficiently precise due to the combining of two separate products in one claim. The claims begin by discussing a listening supplement, but subsequently the claims then deal with the specifics of a carrier for the listening supplement. In light of the specification, the claim is interpreted as a product claim for the listening supplement and the carrier for. Appropriate clarification is required.

Additionally, claim 1 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the Applicant means by the limitation a listening supplement containing any type of coverage, since the earlier limitation of a listening supplement having highlights or "cover stories," would be encompassed by this limitation as well. It is interpreted to mean any type of coverage including highlights or "cover stories." Appropriate clarification is required. Additionally, it is unclear if any type of coverage is audio content that can be heard as the highlights or "cover stories." It is interpreted to mean that any type of coverage is also referring to audio content.

Furthermore, claim 1 recites "a listening supplement" in various limitations. It is unclear if each recitation of "a listening supplement" is referring to the same listening supplement or they are all different listening supplements. In light of the specification, it is interpreted to mean the Applicant is referring to "the" listening supplement and that there is just one listening supplement. The same problem is also present with the recitation of "a carrier device," since it is unclear if there is just one carrier device or if there are different carrier devices. In light of the specification, it is interpreted to mean that there is just one carrier device, and the Applicant means "the" carrier device.

Additionally, in reference to claim 1, is unclear if all of the content contained in the listening supplement is in audio format, since the claim discusses separate data storage areas such as tracks, chapter, etc., and since the claim states that highlights or "cover stories" are read but doesn't say if any type of coverage is also read or if that information can be textual. It is interpreted to mean the listening supplement in its entirety is in audible format.

In addition, the limitation, "a listening supplement providing a medium by which advertisers of periodicals reach their target audience through the use of data storage space," is unclear, since it does not actually recite including advertisements on the listening supplement. In light of the specification, it is interpreted to mean that advertising commercials are placed on the listening medium along with other content.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under U.S.C. 103(a) as being unpatentable over the article titled, "The Inside Track; Hot Corner," by Larry Stewart, published in Los Angeles Times on November 21, 2002 on Page 2 (hereinafter Stewart) in view of the article titled, "Newsday Student Briefing Page On The News," by Stephen Williams, published in Newsday on March 28, 1996 on Page A.29 (hereinafter Williams) and further in view of

the article titled, "Gap's New Holiday Ad Campaign Will "Put a Little Love in Your Heart;" Musical Icons and Holiday Giving Campaign Create Magic This Season," published in Business Wire on November 19, 2003 on Page 1 (hereinafter Gap), and further in view of Lacomis Patent Number 6,905,019 (hereinafter Lacomis).

In reference to claim 1, Stewart teaches a listening supplement that provides an additional or alternative means of media content delivery of periodical publications for subscribers of the aforementioned periodical publications and a process for establishing the same (page 1 lines 5-8 and 16-19) comprising: a listening supplement contained as an insert to a periodical (i.e. a CD and/or DVD) (page 1 lines 5-8 and 16-19); a listening supplement having highlights or "cover stories" read by an editor or author of the story (Newscaster, Public Relations professional, Public Radio announcers, etc.) (i.e. look back at ABC's "Wide World of Sports," and reviews of home run records are both examples of highlights) (page 1 lines 5-8, 16-19, and 22-27 and page 2 lines 7-9); a listening supplement containing any type of coverage that the said periodical publication designates (i.e. interview, "Heidi Game," etc) (page 1 lines 22-27 and page 2 lines 1-9).

Stewart does not specifically teach a listening supplement containing a table of contents with each separate piece of media content on separate data storage areas (e.g., tracks, chapters); a listening supplement wherein the listener is able to reach each piece of media content in discrete steps; a listening supplement providing a medium by which advertisers of periodicals reach their target audience through the use of data storage space; a listening supplement stored in a bi-folded carrier device with a clear plastic front and an envelope flap on back; and a carrier with a single sheet of

paperboard folded along a bi-fold line with an envelope flap on the back of one side of the bi-fold (See Fig. 4).

Williams teaches a listening supplement containing a table of contents with each separate piece of media content on separate data storage areas (e.g., tracks, chapters) (page 1 lines 6-12 and page 2 lines 16-22); a listening supplement wherein the listener is able to reach each piece of media content in discrete steps (page 1 lines 11, 12, 21, and 22). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Stewart to include a table of contents with each separate piece of media content on separate data storage areas (e.g., tracks, chapters) wherein the listener is able to reach each piece of media content in discrete steps to enable the user to select the content on the CD's and DVD's in the order desired by the user without having to spend the time in manually fast forwarding the content to reach the desired program.

Gap teaches a listening supplement providing a medium by which advertisers of periodicals reach their target audience through the use of data storage space (i.e. by placing Gap's commercial on the CD featuring other paid recordings) (page 1 lines 1-8 and page 2 lines 6-12). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Stewart to include a medium by which advertisers of periodicals reach their target audience through the use of data storage space by adding advertisements to the CD's to enable the publisher to target the user by advertising other similar products that are available with supplemental materials, since this user has already expressed an interest in those type of products by

Art Unit: 3622

purchasing the first product bundled with the CD's and DVD's, and may be interested in suggestions for other similar products.

Lacomis teaches a listening supplement stored in a bi-folded carrier device with an envelope flap on back (see at least col. 1 lines 1-29, col. 2 lines 26-31, col. 5 lines 43 to col. 6 lines 5, Figures 1, 4, and 5); and a carrier with a single sheet of paperboard folded along a bi-fold line with an envelope flap on the back of one side of the bi-fold (see at least col. 1 lines 1-29, col. 2 lines 26-31, col. 5 lines 43 to col. 6 lines 5, Figures 1, 4, and 5).

Lacomis doesn't teach the carrier device to include a clear plastic front. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a clear plastic front on the carrier device as an obvious matter of design choice. Since this would allow the user to view the title or other information printed on the actual CD without having to remove it from the carrier while still serving the same function and achieving the same result of storing a listening supplement. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Stewart to store the CD's and DVD's in a bi-folded carrier device with an envelope flap on back with a clear plastic front and a carrier with a single sheet of paperboard folded along a bi-fold line with an envelope flap on the back of one side of the bi-fold as an obvious matter of design choice. Since this would allow the user to view the title or other information printed on the actual CD without having to remove it from the carrier while still serving the same function and achieving the same result of

Art Unit: 3622

storing a listening supplement as done by attaching the CD's or DVD's to the front cover as taught by Stewart (page 1 lines 6-8 and 17-19).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The FAX number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

August 24th, 2007


RETTA YEHDEGA
PRIMARY EXAMINER